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10/766,541

01/28/2004

David Robison

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08/16/2005

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EXAMINER

GRAY, LINDA L

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Best Available Copy

**Office Action Summary**

Application No.

10/766,541

Applicant(s)

ROBISON ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 and 9 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 8 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date filed 7-25-05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Claim Rejections - 35 USC § 102**

**1.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Farrow (US 5,970,640).**

Farrow teaches a method of applying a seam tape along an edge of a sheet of membrane 11 wherein the tape includes pressure sensitive adhesive strip 12 covered on a first surface with release sheet 13 (c 1, L 65, to c 2, L 49; c 2, L 48, to c 3, L 25). The method includes applying the tape to a center portion of membrane 11 by pressing to some degree a second top surface of the tape against membrane 11 to bond (c 2, L 40-47). Then the method includes cutting membrane 11 into two sheets by cutting through membrane 11 and the tape along a central portion of the tape to form the two sheets having a continuous portion of the tape along one edge. With respect to the limitation in claim 1 of "adapted for use as one of a roofing membrane and a pond liner", such refers to an intended use of the two sheets made using the claimed method and does not provide patentable subject matter to claim 1. The limitation does not further limit the steps of the claimed method.

**Claim Rejections - 35 USC § 103**

**3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrow in view of Leibmann.**

*Farrow does not teach cutting while applying the tape.*

However, Liebmann teaches a method of applying seam tape 14 along an edge of a sheet of membrane 20 wherein tape 14 includes pressure sensitive adhesive strip 15 covered on a first surface with release sheet 12. The method includes applying tape 14 to a center portion of membrane 20 by pressing a second top surface of tape 14 against membrane 20. Then the method includes cutting membrane 20 into two sheets by cutting through membrane 20 and tape 14 along a central portion of tape 14 to form the two sheets having a portion of tape 14 along one edge. See Figures 3 and 3A which teaches an apparatus that demonstrates cutting while applying tape 14 (c 3-6).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Farrow cutting while applying the tape because Liebmann teaches in the same art of applying tape to a surface that such is conventional in the art and it is obvious to replace one method to apply/cut tape (that of Farrow) with another art recognized alternative method to apply/cut tape (that of Liebmann) where Farrow does not place restrictions on the cutting operation such that one skilled in the art would not consider the modification to be detrimental to the process of Farrow.

**4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrow.**

*Farrow teaches membrane 11 to be paper and not EPDM.*

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However, in the art of making signs, where Farrow is making signs (c 1, para 1), EPDM is a conventional alternative sign material, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Farrow that membrane 11 be EPDM because it is obvious to replace one material for a sign with another art recognized alternative sign material.

**Allowable Subject Matter**

**5. Claim 3 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

**Claims 4-6 and 9 are allowed.**

**6.** The following is a statement of reasons for the indication of allowable subject matter:

**claim 3:** in Farrow in view of Liebmann membrane 11 is supported on a surface where a surface having central grooves aligned with a portion of a material to be cut is conventional; however, Farrow does not teach a seam tape applicator sheet splitter to be run along membrane 11 to apply the tape and cut membrane 11 in that in Farrow modified membrane 11 is moved past stationary applicators and cutters,

**claim 6:** Farrow in view of Liebmann teaches an apparatus for applying the seam tape along an edge of membrane 11 including a seam tape applicator having a contact roll adapted to press the tape against a surface of membrane 11 where the applicator supports a roll of the tape where the tape includes pressure sensitive adhesive layer 12 having first and second adhesive surfaces and release sheet 13 covering one of the adhesive surfaces, and a splitter adapted to slit through the tape and membrane 11 where the limitation of membrane 11 being a roofing membrane per se refers to the material operated upon and does not further limit the structure of the apparatus claimed; however, Farrow modified by Liebmann does not teach that the apparatus includes a handle providing means to push the apparatus over membrane 11 in that in Farrow modified membrane 11 is moved past stationary applicators and cutters, and

**claim 9:** Farrow in view of Liebmann teaches an apparatus for applying the seam tape along an edge of membrane 11 including a seam tape applicator having a contact roll adapted to press the tape against a surface of membrane 11 where the applicator supports a roll of the tape where the tape includes pressure sensitive

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adhesive layer 12 having first and second adhesive surfaces and release sheet 13 covering one of the adhesive surfaces, and a slitter adapted to slit through the tape and membrane 11 where the limitation of membrane 11 being a roofing membrane per se refers to the material operated upon and does not further limit the structure of the apparatus claimed; however, Farrow modified by Liebmann does not teach guides which includes a plurality of disks located along a central axis of the apparatus.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

**Response**

8. Applicant's comments filed 7-25-05 have been fully considered. The allowability of claims 1-2 and 8 has been withdrawn in view of the reference to Farrow, and this action is therefore nonfinal.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda L. Gray whose telephone number is (571) 272-1228. The examiner can normally be reached on Monday-Friday, 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg

August 15, 2005

  
LINDA GRAY  
PRIMARY EXAMINER